

IN THE UNITED STATE PATENT AND TRADEMARK OFFICE

Applicant:	Borelli et al.)	
Serial No.	09/992,379)	Examiner: Buchanan, Christopher
Filed:	November 19, 2001)	Art Unit: 3627
Title:	System And Method For)	Attny Docket: 10547.20US2
	Provisioning Network)	
	Services)	

REPLY BRIEF

Via EFS-Web

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Reply to the Examiner's Answer dated November 12, 2008.

This Reply Brief is being filed electronically via EFS-Web.

The Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

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Gladys Negrón-Munoz

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

It is respectfully submitted that the rejections under 35 U.S.C. § 103, as repeated in the Examiner's Answer, must be withdrawn because the rejections fail to demonstrate or even allege that all of the claimed elements, considering each and every word thereof, were known in the prior art and that one skilled in the art could have combined the known elements by known methods with no change in their respective functions with the combination yielding nothing more than predictable results. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395. Rather, it is clear that the claimed invention has been impermissibly distilled down to some "gist" or "thrust" in complete disregard of the requirement that the claimed subject matter be analyzed "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

i) The rejection of claims 1-5 and 9-19

Turning to the rejection of claims 1-5 and 9-19, the rejection fails to establish a *prima facie* case of obviousness. In particular, the rejection fails to demonstrate where Dickinson, alone or in combination with any other reference, discloses each and every element of the claims, considering each and every word thereof. Among other things, the rejection has not even alleged that Dickinson, alone or modified, includes the expressly claimed "receiving a user selection of one or more services *that have been deemed to be available to the user via the network.*" Rather, the rejection has only set forth that Dickinson discloses "receiving a user selection for one or more services available via the

network.” Similarly, the rejection has not alleged that Dickinson, alone or as modified, includes the expressly claimed “authenticating the user identifier *with an ISP*” or the expressly claimed “communicating the user identifier to *each provider of a selected service*.” Rather, the rejection has only set forth that Dickinson discloses authenticating user information and communicating it to the service provider. Thus, for the mere reason the rejection of claims 1-5 and 9-19 never concludes or otherwise demonstrates where each and every element of claims 1-5 and 9-19, considering each and every word thereof, is disclosed by the prior art, a *prima facie* case of obviousness has not been established and the rejection of claims 1-5 and 9-19 must be withdrawn.

While it has been acknowledged that Dickinson fails to disclose the very elements of claims 1-5 and 9-19 that are at the core of the inventive concept claimed, the rejection of the claims has nevertheless concluded that it would have been obvious to modify Dickinson to arrive at the invention claimed as “a matter of design choice.” It is, however, respectfully submitted that the claimed elements that are missing from Dickinson, e.g., receiving a user selection of one or more services *that have been deemed to be available to a user*, authenticating the user identifier *with an ISP*, communicating the user identifier to *each provider of a selected service*, etc., are functional and provide the means by which the claimed system/method provides a centralized point from which a user may select one or more service offered by diverse and distributed network service providers and by which the claimed system/method provides for the integrated billing for any network services so selected. (Ap. Br., pg. 2). Because these claimed elements, as a whole, are functional, these claimed elements do not present “a design choice.” In this regard, “design choices” are discussed in MPEP § 2144.04(VI)(C), and only insofar that

the design choice constitutes a rearrangement of known parts. As Dickinson has been acknowledged to not disclose all of the parts recited in claims 1-5 and 9-19, it is respectfully submitted that the invention recited in claims 1-5 and 9-19 cannot represent a rearrangement of parts, i.e., "a design choice." For this yet further reason it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

ii) The rejection of claims 6-8

With respect to the rejection of claims 6-8, it is likewise submitted that a *prima facie* case of obviousness has not been established as the rejection fails to establish where Dickinson, alone or in combination with any other reference, includes each and every element of the claims, considering each and every word thereof. For example, the rejection has not even alleged that Dickinson, alone or as modified, includes the expressly claimed "catalog of offerings available to end subscribers from multiple providers organized into an aggregated plan *for presentation to the subscriber*, the product catalog *tracking rating guidelines and financial reconciliation rules between providers*." Rather, the rejection has only set forth that Dickinson discloses a system including a catalog of services available to users having rate and payment information. Similarly, the rejection has not asserted that Dickinson, alone or as modified, discloses a rating engine *that reconciles between multiple providers based on the rating guidelines and financial reconciliation rules in the product catalog*." Instead, the rejection merely sets forth that Dickinson discloses a rating engine for processing service usage and reconciling payments. Still further, while the claims expressly recite "a provisioning subsystem *responsible for provisioning and de-provisioning offerings with*

providers...which allow the provider to register a purchase offering by the end customer with the provider” the rejection only asserts that Dickinson discloses a provisioning subsystem that allows services to be provided to the user and creates usage events for processing by the rating engine. Thus, for the simple reason that the rejection of claims 6-8 never asserts or otherwise demonstrates where each and every element of claims 6-8, considering each and every word thereof, is disclosed by the prior art, a *prima facie* case of obviousness has not been established and the rejection of claims 6-8 must be withdrawn.

While it has been acknowledged that Dickinson fails to disclose the very elements of claims 6-8 that are at the core of the inventive concept claimed, the rejection of the claims has nevertheless concluded that it would have been obvious to modify Dickinson to arrive at the invention claimed as “a matter of design choice.” It is, however, respectfully submitted that the claimed elements that are missing from Dickinson, e.g., a catalog of offerings available to end subscribers from multiple providers organized into an aggregated plan *for presentation to the subscriber* where the product catalog *tracks rating guidelines and financial reconciliation rules between providers*, a rating engine *that reconciles between multiple providers based on the rating guidelines and financial reconciliation rules in the product catalog*, a provisioning subsystem *responsible for provisioning and de-provisioning offerings with providers...which allow the provider to register a purchase offering by the end customer with the provider*, etc. are functional and provide the means by which the claimed system/method provides a centralized point from which a user may select one or more service offered by diverse and distributed network service providers and by which the claimed system/method provides for the integrated

billing for any network services so selected. (Ap. Br., pg. 2). Because these claimed elements, as a whole, are functional, these claimed elements do not present "a design choice." In this regard, "design choices" are discussed in MPEP § 2144.04(VI)(C), and only insofar that the design choice constitutes a rearrangement of known parts. As Dickinson has been acknowledged to not disclose all of the parts recited in claims 6-8, it is respectfully submitted that the invention recited in claims 6-8 cannot represent a rearrangement of parts, i.e., "a design choice." For this yet further reason it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

iii) The rejection of claims 20-22

With respect to the rejection of claims 20-22, it is again submitted that a *prima facie* case of obviousness has not been established as the rejection again has not even alleged that Dickinson, alone or in combination with any other reference, includes each and every element of the claims, considering each and every word thereof. For example, the rejection does not assert that Dickinson, alone or as modified, includes the expressly claimed "*storing a universal customer identifier in a database associated with a billing engine and associating the universal customer identifier with the broadband services.*" Similarly, the rejection has not asserted that Dickinson, alone or as modified, includes the expressly claimed "*synchronizing a local customer identifier at each of the respective service providers with the universal customer identifier.*" Rather, the rejection has only set forth that Dickinson discloses a system for communicating user and service information to a billing engine and billing the user for services used. Thus, for the reason that the rejection of claims 20-22 never concludes or otherwise demonstrates

where each and every element of claims 20-22, considering each and every word thereof, is disclosed by the prior art, a *prima facie* case of obviousness has not been established and the rejection of claims 20-22 must be withdrawn.

While it has been acknowledged that Dickinson fails to disclose the very elements of claims 20-22 that are at the core of the inventive concept claimed, the rejection of the claims has nevertheless concluded that it would have been obvious to modify Dickinson to arrive at the invention claimed as "a matter of design choice." It is, however, respectfully submitted that the claimed elements that are missing from Dickinson, e.g., *storing a universal customer identifier in a database associated with a billing engine and associating the universal customer identifier with the broadband services, synchronizing a local customer identifier at each of the respective service providers with the universal customer identifier*, etc., are functional and provide the means by which the claimed system/method provides a centralized point from which a user may select one or more service offered by diverse and distributed network service providers and by which the claimed system/method provides for the integrated billing for any network services so selected. (Ap. Br., pg. 2). Because these claimed elements, as a whole, are functional, these claimed elements do not present "a design choice." In this regard, "design choices" are discussed in MPEP § 2144.04(VI)(C), and only insofar that the design choice constitutes a rearrangement of known parts. As Dickinson has been acknowledged to not disclose all of the parts recited in claims 20-22, it is respectfully submitted that the invention recited in claims 20-22 cannot represent a rearrangement of parts, i.e., "a design choice." For this yet further reason it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

iv) The reliance on figs. 7-9 of Dickinson generally

It is respectfully submitted that the general reliance upon figs. 7-9 of Dickinson as set forth within the Response to Argument is misplaced. Specifically, it is respectfully submitted that figs. 7-9 of Dickinson do not generally disclose, teach, or suggest the elements of the claimed invention above-noted that particularly provide a centralized point from which a user may select one or more service offered by diverse and distributed network service providers and by which the claimed system/method provides for the integrated billing for any network services so selected. (Ap. Br., pg. 2). Rather, figs. 7-9 of Dickinson disclose nothing more than a graphical user interface being used to create templates for each RCD element (illustrated in Fig. 7), a graphical user interface being used to associate RCD element types with RCD group types and associate RCD group types with rate plan types (illustrated in Fig. 8 – enables the dragging and dropping of created RCD elements into RCD groups and RCD groups into rate plans), and a graphical user interface being used to enter data for the RCD elements that have been built into a rate plan (illustrated in Fig. 9). Thus, because figs. 7-9 disclose, teach, or suggest nothing more than a system and method for creating rate plan templates - a representation of the basic structure of the information used by a billing engine but which **does not** include any actual data values themselves (Col. 4, lines 46+) - it is respectfully submitted that figs. 7-9 of Dickinson simply cannot be said to disclose, teach, or suggest any aspect of a system/method claimed by which services are actually provisioned by a user and, thereafter, billed, i.e., actions that require the collection and use of data values. It is further respectfully submitted that it is for this very reason that Dickinson is different than the invention claimed, i.e., Dickinson does not disclose, teach, or suggest a system

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for provisioning network services but instead discloses nothing more than a system and method for creating billing engine templates, and it is for this very reason that the Examiner cannot find within Dickinson any of the above-discussed terms that are set forth within the claims at issue. (see Reply, pg. 9).

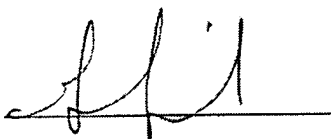
Conclusion

The subject application is considered to be in condition for allowance. Such action on the part of the Board is respectfully requested.

Respectfully Submitted

Date: January 8, 2008

By:



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